



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,933	08/20/2001	Tom Sander	TB-1041A-US	1292

7590 07/02/2003

Donald J. Pochopien
MCANDREWS,HELD, & MALLOY, Ltd.
500 West Madison Street
Suite 3400
Chicago, IL 60661

EXAMINER

SNOW, BRUCE EDWARD

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 07/02/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/701,933	SANDER ET AL.
Examiner	Art Unit	
Bruce E Snow	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 59-71 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 59-71 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

Discussion

This applicant incorrectly claims continuation in part (CIP) to 08/920,630 filed 08/27/97. It is noted ~~the~~^{that} 08/920,630 went abandoned on 04/18/2001 which is prior to ~~08/25/1998~~^{08/20/2001} filing date of ~~08/25/1998~~ for the current application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

62-68
Claims-59-71 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Paul et al (6,258,125).

Paul et al teach a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall

opposite said first side wall, wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall comprising a concave surface. See figure 9 showing two implants useable together.

Claims 59-66, 68-70 are rejected under 35 U.S.C. 102(b) as being **anticipated** by Stroever et al (5,728,159).

Referring to figure 2, Stroever teaches a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall opposite said first side wall, wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall (indicated as P) comprises a concave surface and the first wall (A) comprises a convex surface. Also see the embodiment shown in figure 1 having concave walls L and M.

Regarding claims 62-63, the measurement close to the walls L and M would fulfill the claimed dimensions.

Regarding claims 69-70, the embodiment shown in figure 1 would have the second side wall face inwardly.

Claims 59-71 are rejected under 35 U.S.C. 102(b) as being **anticipated** by Pafford (WO 98/17209).

Referring to all figures specifically figures 25 and 28, Pafford teaches a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall opposite said first side wall,

wherein the first and second side walls extend between the planar surfaces, and wherein the second side wall comprises a concave surface (right side in figure 25) and the first wall (left side in figure 25) comprises a convex surface.

Regarding claims 62-63, the measurement close to the walls L and M would fulfill the claimed dimensions.

Regarding claims 69-70, the concave side wall faces inwardly.

Conclusion

Applicant's amendment including adding language such as "planar surface" to claim 1 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

bes
June 23, 2003



BRUCE SNOW
PRIMARY EXAMINER